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KNOBBE MARTENS OLSON & BEAR LLP			ALI, SHUMAYA B	
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IRVINE, CA 92614			3743	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/663,381	Applicant(s) KAZMIERCZAK ET AL.	
	Examiner Shumaya B. Ali	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/15/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 10-12 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9 and 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of: .
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4,8,15-18,and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over the obviousness of Gaylord US Patent 6,659,971 B2 in view of Jagdat US Patent D 317,840.

2. **As to claim 1, Gaylord discloses** a shoulder sling for supporting a wearer's arm at desired angles of abduction and external rotation, the sling comprising: a support pillow (see fig. 1, cushion 20) including a contoured medial surface (see fig.1 reference object 24) for abutting the wearer's torso (see col.2 lines 44-45), and a lateral surface (see fig.1 reference object 23) for operatively contacting and supporting the wearer's arm; a pouch for receiving and at least partially enclosing the wearer's forearm (see fig.1 reference object 30, col.6 lines 34-35); and a plurality of straps (see fig.1 reference objects 42,46,55,64, and 65) for securing the support pillow and the pouch to the wearer (see col.6. lines 47-50), **however as to claim 1, Gaylord does not disclose** a distance between anterior edges of the medial and lateral surfaces is substantially greater than a distance between posterior edges of the medial and lateral surfaces.

3. **As to claim 1, Jagdat teaches** a pillow with an anterior edge of the medial and lateral surface is substantially greater than a distance between posterior edges of the medial and lateral surfaces (see labeled fig.1)

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4. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the pillow of Gaylord in view of Jagdat in order to provide the pillow with anterior edges of the medial and lateral surfaces is substantially greater than a distance between posterior edges of the medial and lateral surfaces for the purposes of maintaining wearer's arm at a larger angle of rotation.

5. **As to claim 2, Gaylord discloses** the shoulder sling of claim 1, wherein the support pillow retains the wearer's arm in a position of approximately 15° of abduction (see col.9 lines 22-26), **however does not disclose** approximately 15° of external rotation.

6. A close review of the applicant's disclosure reveals that the applicant did not state criticality of the external degrees of rotation as claimed (see page 5). Since the magnitude of rotation, extension, and abduction angles depend upon the size and shape of the support pillow and the length of the straps as disclosed by the applicant (see page 5), Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the shoulder sling of Gaylord to maintain wearer's arm at virtually any angle of abduction, extension or rotation by modify the size and shape of the pillow for the purposes of retaining the wearer's arm in a position of approximately 15° of abduction and approximately 15° of external rotation.

7. **As to claim 3, Gaylord discloses** the shoulder sling of claim 1, wherein the support pillow retains the wearer's arm in a position of approximately 15° of abduction (see col.9 lines 22-26), **however does not disclose** approximately 30° of external rotation.

8. A close review of the applicant's disclosure reveals that the applicant did not state criticality of the external degrees of rotation as claimed (see page 5). Since the magnitude of rotation, extension, and abduction angles depend upon the size and shape of the support pillow and the length of the straps as disclosed by the applicant (see page 5), Therefore, it would have been obvious to one of ordinary skill in

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the art at the time of the invention to modify the shoulder sling of Gaylord to maintain wearer's arm at virtually any angle of abduction, extension or rotation by modify the size and shape of the pillow for the purposes of retaining the wearer's arm in a position of approximately 15° of abduction and approximately 30° of external rotation.

9. **As to claim 4, Gaylord discloses** the shoulder sling of Claim 1, wherein a first one of the straps comprises a torso strap that extends from the support pillow adjacent the anterior edge (see fig.1 intersection line of reference objects 21 and 24) of the medial surface to the support pillow adjacent the posterior edge (see fig.1 intersection line of reference objects 22 and 24) of the medial surface (see col.2 lines 66-67 col.3 lines 1-2).

10. **As to claim 8, Gaylord discloses** the shoulder sling of Claim 1, wherein the pouch is releasably secured to the support pillow lateral surface (see col.2 lines 46-48).

11. **As to claim 15, Gaylord discloses** a shoulder sling for supporting a wearer's arm at desired angles of abduction and external rotation, the sling comprising: a support pillow (see fig.1 cushion 20) including a contoured medial surface (see fig.1 reference object 24) for abutting the wearer's torso, and a lateral surface (see fig.1 reference object 23) for operatively contacting and supporting the wearer's arm; and a plurality of straps (see fig.1 reference objects 43,46,55,64,65) for securing the support pillow to the wearer (see col.6 lines 47-50); **however as to claim 15, Gaylord does not disclose** a distance between anterior edges of the medial and lateral surfaces is substantially greater than a distance between posterior edges of the medial and lateral surfaces.

12. **As to claim 15, Jagdat teaches** a pillow with an anterior edge of the medial and lateral surface is substantially greater than a distance between posterior edges of the medial and lateral surfaces (see labeled fig.1)

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13. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the pillow of Gaylord in view of Jagdat in order to provide the pillow with anterior edges of the medial and lateral surfaces is substantially greater than a distance between posterior edges of the medial and lateral surfaces for the purposes of maintaining wearer's arm at a larger angle of rotation.

14. **As to claim 16, Gaylord discloses** The shoulder sling of Claim 15, further comprising a pouch (see fig.1 reference object 30) for receiving and at least partially enclosing the wearer's forearm (see col.6 lines 34-35).

15. **As to claim 17, Gaylord discloses** the shoulder sling of Claim 15, wherein a first one of the straps comprises a torso strap (see fig.1 reference object 42) that extends from the support pillow adjacent the anterior edge (see fig.1 the intersection line of reference objects 21 and 24) of the medial surface to the support pillow adjacent the posterior edge (see fig.1 the intersection line of reference objects 22 and 24) of the medial surface.

16. **As to claim 18, Gaylord discloses** the shoulder sling of Claim 15, further comprising a shoulder pad (see fig.1 reference object 18) that cooperates with the straps to suspend the support pillow from the wearer's shoulder.

17. **As to claim 22, Gaylord discloses** the shoulder sling of Claim 15, wherein when the support pillow occupies a first orientation it is adapted to support the wearer's right arm, and when the support pillow is inverted from the first orientation it is adapted to support the wearer's left arm (see col.2 lines 25-27).

Claims 5,6,13,19,20, rejected under 35 U.S.C. 103(a) as being unpatentable over Gaylord US Patent 6,659,971 B2, Jagdat US Patent D 317,8405 and in view of Schaefer US Patent 4,598,701

18. **As to claims 5 and 19, Gaylord discloses** the shoulder sling of Claim 4, wherein a second one of the straps comprises a chest strap (see fig.1 reference object 65) that extends from an anterior edge of a shoulder pad (see fig.1 reference object 80); **however does not disclose** the strap extends from the anterior edge of a should pad to an anterior surface of the support pillow

19. **As to claims 5 and 19, Schaefer teaches** a shoulder abduction splint wherein a chest strap (securing strap) (see fig.1 reference object 24) extends from an attachment joint at the should to an anterior surface of a support pillow (see fig.1 reference object A).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the chest strap of Gaylord in view of Schaefer in order to secure the strap that extends from an anterior surface of the support pillow to an anterior edge of a shoulder pad for the purposes of properly support the wearer's arm at the desired angles of abduction and external rotation.

21. **As to claims 6 and 20, Gaylord discloses** the shoulder sling of Claim 5, wherein a third one of the straps comprises a back strap (see fig.3, reference object 55) that extends from a posterior edge of the pouch to a posterior edge of the shoulder pad (see col.7 lines 63-64).

22. **As to claim 13, Gaylord discloses** a shoulder sling for supporting a wearer's arm at desired angles of abduction and external rotation, the sling comprising: a support pillow (see fig. 1, cushion 20) including a contoured medial surface (see fig.1 reference object 24) for abutting the wearer's torso (see col.2 lines 44-45), and a lateral surface (see fig.1 reference object 23) for operatively contacting and supporting the wearer's arm; a pouch for receiving and at least partially enclosing the wearer's forearm (see fig.1 reference object 30, col.6 lines 34-35); and a plurality of straps (see fig.1 reference objects 42,46,55,64, and 65) for securing the support pillow and the pouch to the wearer (see col.6. lines 47-50),

however does not disclose an upper surface of the support pillow includes a straight indicator line that provides a visual cue to the wearer so that the wearer knows when the sling is properly fitted.

23. As to claim 13, Schaefer teaches horizontal strips (see fig.4, reference objects 18-20) attached to the upper surfaces of an abduction pillow for properly securing and adjusting the straps (see col.3 lines 10-15). Therefore, the horizontal strips of Schaefer acts as an indicator line as claimed by the applicant to ensure proper fit and placement of the straps.

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the pillow of Gaylord in view of Schaefer in order to add horizontal strips/straight indicator lines for the purposes of providing a visual cue to the wearer so that the wearer knows when the sling is properly fitted.

Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaylord US Patent 6,659,971 B2 in view of Schaefer US Patent 4,598,701

25. As to claim 23 Gaylord discloses A shoulder sling for supporting a wearer's arm at desired angles of abduction and external rotation, the sling comprising: a support pillow (see fig. 1, cushion 20) including a contoured medial surface (see fig.1 reference object 24) for abutting the wearer's torso (see col.2 lines 44-45), and a lateral surface (see fig.1 reference object 23) for operatively contacting and supporting the wearer's arm; a pouch for receiving and at least partially enclosing the wearer's forearm (see fig.1 reference object 30, col.6 lines 34-35); a shoulder pad (see fig.3 reference object 80) adapted to rest upon the wearer's shoulder; and a plurality of straps (see fig.1 reference objects 42,46,55,64, and 65) for securing the support pillow and the pouch to the wearer (see col.6. lines 47-50), a first strap comprises a torso strap (see fig. 1 reference object 42) that is adapted to extend around the wearer's torso and keep the

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medial surface of the support pillow in abutting contact therewith; a second strap comprises a chest strap (see fig.1 reference object 65) adapted to extend from the anterior edge of the shoulder pad; a third strap comprises a back strap (see fig.3 reference object 55) adapted to support a posterior portion of the support pillow and suspend the posterior portion of the support pillow from a posterior edge of the shoulder pad (see fig.3 reference object 80 col.7 lines 63-64). **However as to claim 23, Gaylord does not disclose the chest strap attach to the anterior surface of the support pillow.**

26. **As to claim 23, Schaefer teaches** a shoulder abduction splint wherein a chest strap (securing strap) (see fig.1 reference object 24) extends from an attachment joint at the shoulder to an anterior surface of a support pillow (see fig.1 reference object A).

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the chest strap of Gaylord in view of Schaefer in order to secure the strap that extends from an anterior surface of the support pillow to an anterior edge of a shoulder pad for the purposes of properly support the wearer's arm at the desired angles of abduction and external rotation.

28. **As to claim 25, Gaylord discloses** the shoulder sling of claim 23, wherein the torso strap further comprises a buckle (see fig.1 reference object 47) adapted to quickly secure the torso strap about the wearer's torso and quickly release the torso strap from the wearer's torso (reference object 47A allows quick secure and release of the torso strap from the wearer's torso) (see col.7 lines 4-10).

Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaylord US Patent 6,659,971 B2 and Jagdat US Patent D 317,840 in view of Bastyr et al. US Patent 5,407,420

29. **As to claims 9 and 21, Gaylord does not disclose** a resilient compressible member secured to an anterior surface of the support pillow.

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30. As to claims 9 and 21, Bastyr et al. teaches an adjustable brace that provides stabilization and immobilization of the shoulder following injury comprising a spherical foam hand bolster attached to the distal end (anterior surface) of a forearm cuff to provide support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand (see fig.1 reference object 40, col.4 lines 64-68). Since Bastyr et. al. forearm is capable of abducting, extending, and rotating a wearer's arm (see col.5 lines 9-12,21-25), Bastyr et al. forearm cuff is considered to act as and meet the same purposes of the pillow disclosed by the applicant. Additionally, a close review of the applicant's disclosure reveals that the purpose and the location of the resilient member are more critical than the specific attachment point. It is important that the member is located where the wearer can easily reach it with the hand on his or her treatment arm (see page 8). Therefore, both the applicant's and Bastyr et al. resilient compressible member are located where the wearer can easily reach it with the hand on his or her treatment arm.

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a resilient compressible member to the pillow of Gaylord in view of Bastyr et al. for the purposes of providing support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand.

Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaylord US Patent

6,659,971 B2 in view of Bastyr et al. US Patent 5,407,420

32. As to claim 14, Gaylord discloses a shoulder sling for supporting a wearer's arm at desired angles of abduction and external rotation, the sling comprising: a support pillow (see fig. 1, cushion 20) including a contoured medial surface (see fig.1 reference object 24) for abutting the wearer's torso (see

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col.2 lines 44-45), and a lateral surface (see fig.1 reference object 23) for operatively contacting and supporting the wearer's arm; a pouch for receiving and at least partially enclosing the wearer's forearm (see fig.1 reference object 30, col.6 lines 34-35); and a plurality of straps (see fig.1 reference objects 42,46,55,64, and 65) for securing the support pillow and the pouch to the wearer (see col.6. lines 47-50), However as to claim 14, Gaylord does not disclose an exercise grip secured to an anterior portion of the support pillow.

33. As to claim 14, Bastyr et al. teaches an adjustable brace that provides stabilization and immobilization of the shoulder following injury comprising a spherical foam hand bolster attached to the distal end (anterior surface) of a forearm cuff to provide support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand (see fig.1 reference object 40, col.4 lines 64-68). Since Bastyr et. al. forearm is capable of abducting, extending, and rotating a wearer's arm (see col.5 lines 9-12,21-25), Bastyr et al. forearm cuff is considered to act as and meet the same purposes of the pillow disclosed by the applicant. Additionally, a close review of the applicant's disclosure reveals that the purpose and the location of the resilient member are more critical than the specific attachment point. It is important that the member is located where the wearer can easily reach it with the hand on his or her treatment arm (see page 8). Therefore, both the applicant's and Bastyr et al. resilient compressible member are located where the wearer can easily reach it with the hand on his or her treatment arm.

34. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a resilient compressible member to the pillow of Gaylord in view of Bastyr et al. for the purposes of providing support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand.

Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaylord US Patent 6,659,971 B2 and Schaefer US Patent 4,598,701 in view of Bastyr et al. US Patent 5,407,420

35. As to claim 24, Gaylord does not disclose a resilient compressible member secured to an anterior surface of the support pillow.

36. As to claims 24, Bastyr et al. teaches an adjustable brace that provides stabilization and immobilization of the shoulder following injury comprising a spherical foam hand bolster attached to the distal end (anterior surface) of a forearm cuff to provide support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand (see fig.1 reference object 40, col.4 lines 64-68). Since Bastyr et. al. forearm is capable of abducting, extending, and rotating a wearer's arm (see col.5 lines 9-12,21-25), Bastyr et al. forearm cuff is considered to act as and meet the same purposes of the pillow disclosed by the applicant. Additionally, a close review of the applicant's disclosure reveals that the purpose and the location of the resilient member are more critical than the specific attachment point. It is important that the member is located where the wearer can easily reach it with the hand on his or her treatment arm (see page 8). Therefore, both the applicant's and Bastyr et al. resilient compressible member are located where the wearer can easily reach it with the hand on his or her treatment arm.

37. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a resilient compressible member to the pillow of Gaylord in view of Bastyr et al. for the purposes of providing support for the hand and a means for exercising the arm while the shoulder is immobilized by firmly gripping the bolster with the hand.

Allowable Subject Matter

Claims 7,10, and 12 are allowed.

38. The following is a statement of reasons for the indication of allowable subject matter: as to above allowed claims, the prior art of record does not teach nor render obvious the overall claimed combination of an anti-rotation strap that extends from an anterior edge of the shoulder pad to the support pillow. Additionally the prior arts of record disclose shoulder sling comprising straps that can be used as anti-rotation straps, but do not disclose anti-rotation straps attached to the posterior surface of a pillow. Therefore, the inventions defined in claims 7,10,11, and 12 are novel.

Conclusion

39. The prior art of record and not relied upon is considered pertinent to applicant's disclosure: US Patents 3404680A, 5407430A, 5792083A, 6007500A, 6113562A, 6659971B2, and D3178405 disclose shoulder abduction device.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30 am-4:30 pm.

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-6088.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from

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either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shumaya Ali
Shumaya B. Ali
Examiner
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12/23/2004

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